

DETAILED ACTION

Prosecution History

1. The Examiner notes that an abandonment notice was sent on **June 17, 2009**. However, a petition to revive an unintentionally abandoned application was received on **July 28, 2011**, which was later granted on **August 23, 2011**.

Status of Claims

1. **Claims 1, 4, 5, 10 – 12, and 14 – 16** have been **amended**.
2. **No claims** have been **cancelled** or **added**.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1 – 17** are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Based upon consideration of all of the relevant factors with respect to the claims as a whole, **claims 1 – 17** are held to claim an abstract idea, and are therefore rejected as ineligible subject matter under 35 U.S.C. 101. The rationale for this finding is explained below:

Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to an examiner is that one clue to patent eligibility under 35 USC § 101 is whether or not the process is (1) be tied to a particular machine or apparatus or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S.

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584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

The claim should recite the particular machine or apparatus to which it is tied, for example by identifying the machine or apparatus that accomplishes the method steps, or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

Here, applicant's method steps fail the first prong of the new test because there is not tie to any kind of machine or any of the claimed steps. The Examiner asserts that the claims fail to disclose the use of a particular machine for performing the claimed invention. Although an entertainment device is a machine it does not perform the steps of the claimed method. That is to say, the device is not performing the steps of accepting a reservation, adding a reservation to a manifest, comparing the reserved devices with a default number, reserving the devices for rental, receiving a voucher, exchanging the voucher for the device, brining on an additional amount of devices, and

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etc. The Examiner asserts that the acts of storing and presenting an audiovisual presentation are considered to be insignificant extra solution activities in that the mere act of data gathering and outputting are insignificant and insufficient to overcome the test. The claims do not pass the first test of Bilksi to providing a tie to a particular machine.

Further, applicant's method steps fail the second prong of the test because there is no transformation of the data. It is asserted that the data has not been transformed into another state or into another object.

The applicant is reminded that:

"Purported transformation or manipulations simply of public or private legal obligations or relationships, business risks, or other such abstractions cannot meet the test because they are not physical objects or substances, and they are not representative of physical objects or substances.

(In re Bernard L. Bilski and Rand A. Warsaw Page 28)"

Moreover, the "transformation must be central to the purpose of the claimed process.

(In re Bernard L. Bilski and Rand A. Warsaw Page 28)"

Additionally, other factors and considerations in addition to the machine/transformation test also point to a finding that the claims are directed to a mere abstract idea. The claims seem to be a mere statement of a general concept of media or device rental for in-flight entertainment. The claims if allowed would appear to effectively grant a monopoly on the concept of media/device rental. The process of generating a receiving a rental reservation and providing the rental service, i.e. providing the device for in-flight entertainment, could be performed by any currently

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known or future manner of rental processing, or even done by human beings because no machine is recited explicitly or implied in the claims, which has been programmed to perform this step. Although an in-flight rental device is used to store and view the media, it is asserted that the machine is merely directed to an insignificant extra solution activity. The claims seem to be directed to a general business concept of media/device rental, which seems to be just a general business concept. When viewing these factors and the claims as whole, it is concluded that the claims are directed to a mere abstract idea and are not patent eligible under 35 USC 101.

Dependent **claims 2 – 17** when analyzed as a whole are held to be patent ineligible under 35 U.S.C. 101 because the additional recited limitation(s) fail(s) to establish that the claims are not directed to an abstract idea, for the same reasoning as set forth with respect to **claim 1**. The dependent claims do not act to remedy the problem with **claim 1** by reciting (explicitly or implied) the use of any particular machine and/or any significant transformation.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1, 2, 3, 10, and 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Inselberg (US Patent 6,760,595 B2) in view of Maskell**

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(Distribution Resource Planning) in further view of **Wakai (US Patent 5,973,722)** and in further view of **Dixon (US Patent 4,521,021)**.

5. In regards to **claims 1 and 11**, **Inselberg** discloses a method comprising:
accepting a reservation for rental of a self-contained entertainment device for use on an event **(Col. 5 Lines 33 – 37 wherein the device is reserved ahead of time as part of the price of the ticket for the event)**;

Inselberg does not explicitly disclose:

adding the reservation to a manifest containing at least a count of self-contained entertainment devices reserved for an event.

However, one of ordinary skill looking upon the teachings of **Inselberg** would have noted that **Inselberg** discloses that the devices can be an additional cost added to the purchase of the ticket for the specified event. With that said, the Examiner asserts that one having ordinary skill in the art would have realized that a manifest would have been provided since **Inselberg** discloses that the electronic devices can be picked up at the event. In other words, one of ordinary skill in the art would have realized that a manifest must have been provided for each prepaid electronic device in order to prevent a customer paying twice for the rental of the device at a pickup station, determine the amount of devices needed, and to know which customers would have been required to pay for the rental of the device if it was not purchased during the purchase of admission.

Therefore, it would have been obvious to one having ordinary skill in the art that **Inselberg** does, indeed, disclose adding a reservation to a manifest in order to provide a list of the amount of entertainment devices needed.

However, **Inselberg** fails to explicitly disclose:

comparing the count of self-contained entertainment devices reserved for the event with a default number indicating how many entertainment devices are stored at the event;

when the count of self-contained entertainment devices reserved for the event is larger than the default number by a difference, bringing to the event before the event commences an additional number of self-contained entertainment devices at least as large as the difference; and

wherein the self-contained entertainment devices are for in-flight use.

Maskell discloses that it is old and well known that comparing the amount of a product on hand with what is required is a well established concept in inventory control management. Specifically, **Maskell** discloses a DRP system with the ability to identify products that are in short supply at a specific location and transfers items from location to another in order to meet customer orders (**see at least Page 3 – Allocation of products in short supply**). Consequently, one having ordinary skill in the art looking upon the teachings of **Maskell** would have found it obvious that it is old and well known to determine the amount of inventory at one location, compare the current stock at that location, and have additional products transferred if the current stock is too low to meet customer needs.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify **Inselberg** with the teachings of **Maskell** in order to provide a method and system that controls the amount of inventory at a location in order

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to meet customer orders as well as providing a balance of inventory at different locations by transferring products from one location to another.

Inselberg discloses that the entertainment devices can be used at a variety of locations and events without changing the teaching of renting out entertainment devices to customers. In other words, the location does not change how the method carries out the rental.

However, for purposes of expediting prosecution **Wakai** discloses that it is old and well known for airlines to have in-flight entertainment and to rent the devices for enjoying the in-flight entertainment.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the teachings **Inselberg and Maskell** to include in-flight entertainment, as taught by **Wakai**, in order to expand their audience.

The **combination of Inselberg, Maskell, and Wakai** discloses a system and method that allows a user, i.e. a passenger of an airline, to rent a device and be provided with entertainment through the device. Specifically, **Inselberg** teaches that it is old and well known to allow users to rent portable devices that wirelessly transmit information from a central location to the device. **Wakai** teaches a similar system and method, but instead of wireless receiving entertainment the device is part of a network system that receives information from a server like system located in an aircraft through a wired connection. In other words, the **combination** teaches that information can be received through a variety of different means, but fails to disclose an embodiment where a device is provided to a user which already contains the entertainment stored therein.

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In other words, although the **combination** has established that information can be provided to a user wirelessly and wired, the **combination** fails to disclose that information can be provided to a user by storing the entertainment on the device itself.

To be more specific, the **combination of Inselberg, Maskell, and Wakai** fails to disclose:

the reserved self-contained in-flight entertainment device being configured to present to one or more passengers of the commercial airline flight audiovisual presentations consisting of those loaded on the self-contained in-flight entertainment device prior to pickup by the one or more passengers.

Dixon, on the other hand, discloses that it is old and well known in the art of in-vehicle entertainment to provide users with a device that already contains the entertainment stored therein. To be more specific, **Dixon** discloses that it is old and well known in the art to provide a passenger of a vehicle, such as airlines, with a device that contains entertainment stored therein without the need to connect to a remote location in order to receive the entertainment. One of ordinary skill in the art would have further found it obvious that the device is also being rented by the passenger because the device can only be used as long as the passenger is on the vehicle (**see at least Abstract; Figures 1 – 3; Col. 3 Lines 10 – 46**).

The **combination of Inselberg, Maskell, and Wakai** teaches a consumer electronic device that can be rented and allows for entertainment to be provided to a user while the user is at a specified location.

The sole difference between the **combination** and the claimed subject matter is that the **combination** does not disclose that the entertainment is already stored on the device.

Dixon shows that a passenger can be provided with in-flight entertainment by providing the passenger with a device that has preloaded content and shows that it was known in the prior art at the time of the invention.

Since each individual element and its functions are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself-that is in the substitution of providing entertainment by way of a preloaded device, as taught by **Dixon**, for the remote transmission of entertainment to a device, as taught by the **combination of Inselberg, Maskell, and Wakai**.

Thus, the simple substitution of one known element for another producing a predictable result renders the claim obvious. The Examiner asserts that the **combination of Inselberg, Maskell, and Wakai** teaches that the business practice of allowing a user to rent a device, providing the user with a device, and providing in-flight entertainment is well known in the art and that the sole difference between the **combination of Inselberg, Maskell, and Wakai** and the claimed invention is how the entertainment is being provided, which is where **Dixon** is included to teach this missing, yet well known, concept/feature.

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6. In regards to **claim 2, the combination of Inselberg, Maskell, Wakai, and Dixon** fails to explicitly disclose further including delivering the manifest to the aircraft before the commercial airline flight commences.

However, as discussed above, **Inselberg** discloses that a manifest must be provided in order to know how many devices will be needed and if the current inventory meets the required demand. Consequently, one having ordinary skill in the art would have found it to be common sense for the manifest to be available before an event in order to ensure that the demand can be met by providing all of the requested devices before the event, in this case before the flight, and providing the necessary information to determine which customers have rented a device.

7. In regards to **claim 3, the combination of Inselberg, Maskell, Wakai, and Dixon** discloses wherein the reserving further includes reserving a commercial airline flight (**Col. 5 Lines 33 – 37; wherein Inselberg discloses that the device can be part of the price of admission, i.e. purchase of the ticket to the event**).

8. In regards to **claim 10, Inselberg** discloses a method comprising:

accepting a reservation for rental of a self-contained entertainment device for use on during an event (**Col. 5 Lines 33 – 37 wherein the device is reserved ahead of time as part of the price of the ticket for the event**).

Inselberg does not explicitly disclose:

adding the reservation to a manifest containing at least a count of self-contained entertainment devices reserved for the event.

However, one of ordinary skill looking upon the teachings of **Inselberg** would have noted that **Inselberg** discloses that the devices can be an additional cost added to the purchase of the ticket for the specified event. With that said, the Examiner asserts that one having ordinary skill in the art would have realized that a manifest would have been provided since **Inselberg** discloses that the electronic devices can be picked up at the event. In other words, one of ordinary skill in the art would have realized that a manifest must have been provided for each prepaid electronic device in order to prevent a customer paying twice for the rental of the device at a pickup station, determine the amount of devices needed, and to know which customers would have been required to pay for the rental of the device if it was not purchased during the purchase of admission.

Therefore, it would have been obvious to one having ordinary skill in the art that **Inselberg** does, indeed, disclose adding a reservation to a manifest in order to provide a list of the amount of entertainment devices needed.

However, **Inselberg** fails to explicitly disclose:

comparing the count of self-contained entertainment devices reserved for the event with a default number indicating how many in-flight entertainment devices are kept at a pickup location near origination of the event;

when the count of self-contained entertainment devices reserved for the event is larger than the default number by a difference, bringing to the pickup location before the event commences an additional number of self-contained entertainment devices at least as large as the difference; and

wherein the self-contained entertainment devices are for in-flight use.

Maskell discloses that it is old and well known that comparing the amount of a product on hand with what is required is a well established concept in inventory control management. Specifically, **Maskell** discloses a DRP system with the ability to identify products that are in short supply at a specific location and transfers items from location to another in order to meet customer orders (**see at least Page 3 – Allocation of products in short supply**). Consequently, one having ordinary skill in the art looking upon the teachings of **Maskell** would have found it obvious that it is old and well known to determine the amount of inventory at one location, compare the current stock at that location, and have additional products transferred if the current stock is too low to meet customer needs.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify **Inselberg** with the teachings of **Maskell** in order to provide a method and system that controls the amount of inventory at a location in order to meet customer orders as well as providing a balance of inventory at different locations by transferring products from one location to another.

Inselberg discloses that the entertainment devices can be used at a variety of locations and events without changing the teaching of renting out entertainment devices to customers. In other words, the location does not change how the method carries out the rental.

However, for purposes of expediting prosecution **Wakai** discloses that it is old and well known for airlines to have in-flight entertainment and to rent the devices for enjoying the in-flight entertainment.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the teachings **Inselberg and Maskell** to include in-flight entertainment, as taught by **Wakai**, in order to expand their audience.

The **combination of Inselberg, Maskell, and Wakai** discloses a system and method that allows a user, i.e. a passenger of an airline, to rent a device and be provided with entertainment through the device. Specifically, **Inselberg** teaches that it is old and well known to allow users to rent portable devices that wirelessly transmit information from a central location to the device. **Wakai** teaches a similar system and method, but instead of wireless receiving entertainment the device is part of a network system that receives information from a server like system located in an aircraft through a wired connection. In other words, the **combination** teaches that information can be received through a variety of different means, but fails to disclose an embodiment where a device is provided to a user which already contains the entertainment stored therein. In other words, although the **combination** has established that information can be provided to a user wirelessly and wired, the **combination** fails to disclose that information can be provided to a user by storing the entertainment on the device itself.

To be more specific, the **combination of Inselberg, Maskell, and Wakai** fails to disclose:

the reserved self-contained in-flight entertainment device being configured to present to one or more passengers of the commercial airline flight audiovisual presentations consisting of those loaded on the self-contained in-flight entertainment device prior to pickup by the one or more passengers.

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Dixon, on the other hand, discloses that it is old and well known in the art of in-vehicle entertainment to provide users with a device that already contains the entertainment stored therein. To be more specific, **Dixon** discloses that it is old and well known in the art to provide a passenger of a vehicle, such as airlines, with a device that contains entertainment stored therein without the need to connect to a remote location in order to receive the entertainment. One of ordinary skill in the art would have further found it obvious that the device is also being rented by the passenger because the device can only be used as long as the passenger is on the vehicle (**see at least Abstract; Figures 1 – 3; Col. 3 Lines 10 – 46**).

The **combination of Inselberg, Maskell, and Wakai** teaches a consumer electronic device that can be rented and allows for entertainment to be provided to a user while the user is at a specified location.

The sole difference between the **combination** and the claimed subject matter is that the **combination** does not disclose that the entertainment is already stored on the device.

Dixon shows that a passenger can be provided with in-flight entertainment by providing the passenger with a device that has preloaded content and shows that it was known in the prior art at the time of the invention.

Since each individual element and its functions are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself-that is in the substitution of providing entertainment by way of a preloaded device,

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as taught by **Dixon**, for the remote transmission of entertainment to a device, as taught by the **combination of Inselberg, Maskell, and Wakai**.

Thus, the simple substitution of one known element for another producing a predictable result renders the claim obvious. The Examiner asserts that the **combination of Inselberg, Maskell, and Wakai** teaches that the business practice of allowing a user to rent a device, providing the user with a device, and providing in-flight entertainment is well known in the art and that the sole difference between the **combination of Inselberg, Maskell, and Wakai** and the claimed invention is how the entertainment is being provided, which is where **Dixon** is included to teach this missing, yet well known, concept/feature.

9. **Claims 4, 12, 13, and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Inselberg (US Patent 6,760,595 B2) in view of Maskell (Distribution Resource Planning)** in further view of **Wakai (US Patent 5,973,722)** in further view of **Dixon (US Patent 4,521,021)**, and in further view of **Official Notice**.

10. In regards to **claim 4, the combination of Inselberg, Maskell, Wakai, and Dixon** transferring the additional requested items from one location to another (**Maskell; Page 3 Allocation of products in short supply**).

However, **the combination of Inselberg, Maskell, Wakai, and Dixon** fails to explicitly disclose wherein the bringing is performed using a catering service for the

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commercial airline flight wherein a supply truck of the catering service delivers the additional number of self-contained in-flight entertainment devices to the aircraft, i.e. that the delivering is carried out by a truck.

However, **Official Notice** is taken that there are various methods of delivering items and, as a result, it would have been obvious to one having ordinary skill in the art that delivering items in a truck are just one of the many known methods of delivery, at the time of the invention.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify **the combination of Inselberg, Maskell, Wakai, and Dixon** in view of **Official Notice** to deliver the requested items in a truck in the event that a large delivery is required.

In regards to the delivery being performed by a catering service, the Examiner asserts that this limitation does not further limit the steps of the claimed invention. The Examiner asserts that the phrase "catering service" is merely being used as a label that is being attached to the provider of the trucking service. The Examiner asserts that there is no real catering being performed and, thus, adds little, if anything, to the claimed steps and does not serve to distinguish over the prior art. Any differences related merely to the meaning and information conveyed through labels which does not explicitly alter or impact the steps of the method does not patentably distinguish the claimed invention from the prior art in terms of patentability. The Examiner asserts that one of ordinary skill in the art would have found it obvious that any service provider that

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provides a service, in this case the delivery of the devices, reads over the claimed invention.

11. In regards to **claim 12, the combination of Inselberg, Maskell, Wakai, and Dixon** fails to explicitly disclose wherein a pickup location for the reserved self-contained in-flight entertainment devices is inside of a high security area.

However, **Official Notice** is taken that it is old and well known for public areas, such as sporting arenas and airports, to contain high security areas, especially where expensive items are being sold or rented. In other words, one having ordinary skill in the art would have found it obvious to store and distribute expensive items in a high security area such as after gate entrances of sporting arenas and airports.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the **the combination of Inselberg, Maskell, Wakai, and Dixon** in view of **Official Notice** to have the pickup locations inside a high security area.

12. In regards to **claim 13, the combination of Inselberg, Maskell, Wakai, Dixon, and Official Notice** discloses wherein the pickup location is a kiosk counter or a gate counter (**Inselberg - Col. 5 Lines 60 – 32**).

13. In regards to **claim 14, the combination of Inselberg, Maskell, Wakai, and Dixon** fails to explicitly disclose wherein a pickup location for the reserved self-contained in-flight entertainment devices is a counter of a rental car agency.

However, the Examiner considers that the fact that the pickup location is a counter of a rental car agency to be nonfunctional descriptive subject matter. That is to

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say, the location of where the pickup location adds little, if anything, to the claim's structure, and, thus, does not serve as a limitation on the claim to distinguish it over the prior art. As claimed, the steps of the invention would be performed the same regardless of the location.

Moreover, the Examiner further asserts that rental car agencies are usually found on airport premises and that there are several services that are associated with a passengers flight can be carried out by a car rental agency. Furthermore, it is also old and well known for car rentals, flight reservation, and hotel accommodations to be associated with each other and brought at the same time flight packages and, as a result, it would have also been obvious to one having ordinary skill in the art for a car rental agency to serve as a pick up location for an IFE service or device when a passenger is dropping off a vehicle prior to take-off, for example.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify **the combination of Inselberg, Maskell, Wakai, and Dixon** to have a car rental agency serve as a pickup location for IFE devices.

14. **Claims 5 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Inselberg (US Patent 6,760,595 B2)** in view of **Wakai (US Patent 5,973,722)** and in further view of **Dixon (US Patent 4,521,021)**.

15. In regards to **claims 5 and 7**, **Inselberg** discloses a method comprising:

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reserving for rental of one of a plurality of self-contained entertainment devices for use during an event (**Col. 5 Lines 33 – 37 wherein the device is reserved ahead of time as part of the price of the ticket for the event**);

receiving a voucher associated with the reserving (**obviously included wherein a ticket must be provided in order to enter the event, such as in a sporting event**);

exchanging the voucher for one of the plurality of self-contained entertainment devices (**obviously included since a ticket must be submitted before entering an event; Col. 5 Lines 20 – 37; wherein Inselberg discloses that kiosks are provided and one having ordinary skill in the art would have found it obvious that in order to access the kiosks, where the devices are provided for the event, a ticket must be provided, which provides admission to the event, such as a sporting event,**);

using the self-contained entertainment device during an event (**Col. 2 Lines 34 – 63; wherein the devices are used during an event**); and

exchanging the self-contained entertainment devices for a return acknowledgement (**Col. 5 Lines 27 – 32; wherein the devices are returned**).

Inselberg discloses that the entertainment devices can be used at a variety of locations and events without changing the teaching of renting out entertainment devices to customers. In other words, the location does not change how the method carries out the rental.

However, for purposes of expediting prosecution **Wakai** discloses that it is old and well known for airlines to have in-flight entertainment and to rent the devices for enjoying the in-flight entertainment.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the teachings **Inselberg** to include in-flight entertainment, as taught by **Wakai**, in order to expand their audience.

The **combination of Inselberg and Wakai** discloses a system and method that allows a user, i.e. a passenger of an airline, to rent a device and be provided with entertainment through the device. Specifically, **Inselberg** teaches that it is old and well known to allow users to rent portable devices that wirelessly transmit information from a central location to the device. **Wakai** teaches a similar system and method, but instead of wireless receiving entertainment the device is part of a network system that receives information from a server like system located in an aircraft through a wired connection. In other words, the **combination** teaches that information can be received through a variety of different means, but fails to disclose an embodiment where a device is provided to a user which already contains the entertainment stored therein. In other words, although the **combination** has established that information can be provided to a user wirelessly and wired, the **combination** fails to disclose that information can be provided to a user by storing the entertainment on the device itself.

To be more specific, the **combination of Inselberg and Wakai** fails to disclose:
the reserved self-contained in-flight entertainment device being configured to present to one or more passengers of the commercial airline flight audiovisual presentations consisting of those loaded on the self-contained in-flight entertainment device prior to pickup by the one or more.

Dixon, on the other hand, discloses that it is old and well known in the art of in-vehicle entertainment to provide users with a device that already contains the entertainment stored therein. To be more specific, **Dixon** discloses that it is old and well known in the art to provide a passenger of a vehicle, such as airlines, with a device that contains entertainment stored therein without the need to connect to a remote location in order to receive the entertainment. One of ordinary skill in the art would have further found it obvious that the device is also being rented by the passenger because the device can only be used as long as the passenger is on the vehicle (**see at least Abstract; Figures 1 – 3; Col. 3 Lines 10 – 46**).

The **combination of Inselberg and Wakai** teaches a consumer electronic device that can be rented and allows for entertainment to be provided to a user while the user is at a specified location.

The sole difference between the **combination** and the claimed subject matter is that the **combination** does not disclose that the entertainment is already stored on the device.

Dixon shows that a passenger can be provided with in-flight entertainment by providing the passenger with a device that has preloaded content and shows that it was known in the prior art at the time of the invention.

Since each individual element and its functions are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself-that is in the substitution of providing entertainment by way of a preloaded device,

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as taught by **Dixon**, for the remote transmission of entertainment to a device, as taught by the **combination of Inselberg and Wakai**.

Thus, the simple substitution of one known element for another producing a predictable result renders the claim obvious. The Examiner asserts that the **combination of Inselberg and Wakai** teaches that the business practice of allowing a user to rent a device, providing the user with a device, and providing in-flight entertainment is well known in the art and that the sole difference between the **combination of Inselberg and Wakai** and the claimed invention is how the entertainment is being provided, which is where **Dixon** is included to teach this missing, yet well known, concept/feature.

16. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Inselberg (US Patent 6,760,595 B2) in view Wakai (US Patent 5,973,722)** in further view of **Dixon (US Patent 4,521,021)** and in further view of **Official Notice**.

17. In regards to **claim 6, the combination of Inselberg, Wakai, and Dixon** fails to disclose wherein the return acknowledgement is an electronic document or a paper document.

However, **Inselberg** discloses that after the event is over and the customer has no more use for the device, the device is returned at the kiosk. Although, **Inselberg** does not show that that the return acknowledgement is an electronic document or a

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paper document the Examiner takes **Official Notice** that it is old and well known for many businesses to provide some type of documentation indicating the return of a piece of equipment in order to allow the customer to leave a specified area as well as providing a means for the business to have a simple security feature for securing the business's assets.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention in view of **Official Notice** to modify the **combination of Inselberg and Wakai** to provide some type of documentation when an item is returned in order to provide the customer with a means of providing proof that the device was returned as well as providing the business with the satisfaction of a simple security feature for the means of ensuring that property is properly returned.

18. **Claims 8, 9, 15, 16, and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Inselberg (US Patent 6,760,595 B2) in view Wakai (US Patent 5,973,722)** and in further view of **Official Notice**.

19. In regards to **claim 8, Inselberg** discloses a method comprising:

accepting a reservation for rental of a self-contained entertainment devices for use by a person during an event (**Col. 5 Lines 33 – 37 wherein the device is reserved ahead of time as part of the price of the ticket for the event**).

However, **Inselberg** fails to explicitly disclose:

determining if any number of a plurality of self-contained in-flight entertainment devices stored on board the aircraft require deletion of stored audiovisual presentations and addition of other audiovisual presentations and if so, delivering a quantity of the other self-contained in-flight entertainment devices having the other audiovisual presentations stored to the aircraft for exchange with the any number of self-contained in-flight entertainment devices requiring deletion of store audiovisual presentations.

wherein the self-contained entertainment devices are for in-flight use.

Inselberg discloses that the entertainment devices can be used at a variety of locations and events without changing the teaching of renting out entertainment devices to customers. In other words, the location does not change how the method carries out the rental.

However, for purposes of expediting prosecution **Wakai** discloses that it is old and well known for airlines to have in-flight entertainment and to rent the devices for enjoying the in-flight entertainment.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the teachings **Inselberg** to include in-flight entertainment, as taught by **Wakai**, in order to expand their audience.

However, **the combination of Inselberg and Wakai** fails to disclose:

determining if any number of a plurality of self-contained in-flight entertainment devices stored on board the aircraft require deletion of stored audiovisual presentations and addition of other audiovisual presentations and if so, delivering a quantity of the other self-contained in-flight entertainment devices having the other audiovisual

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presentations stored to the aircraft for exchange with the any number of self-contained in-flight entertainment devices requiring deletion of store audiovisual presentations.

However, **Wakai** does disclose that the in-flight entertainment devices can be preloaded with entertainment, such as movies, video games, and etc. As a result, **Official Notice** is taken that it would have been obvious to one having ordinary skill in the art to exchange the newly ordered IFE devices with the IFE devices already stored on the plane which may be obsolete or having contained outdated entertainment. That is to say, it is old and well known for unnecessary weight, i.e. IFE devices that are no longer needed, to be removed from a plane for safety issues, such as unnecessary fuel consumption, for example.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify **the combination of Inselberg and Wakai** in view of **Official Notice** to exchange the newly ordered IFE devices with the IFE devices already stored on the plane, which were not requested or considered to be obsolete or having contained outdated entertainment.

20. In regards to **claim 9, the combination of Inselberg and Wakai** discloses transferring the additional requested items from one location to another (**Maskell; Page 3 Allocation of products in short supply**).

However, **the combination of Inselberg and Wakai** fails to explicitly disclose that the delivering is carried out by a truck or a catering service.

However, **Official Notice** is taken that there are various methods of delivering items and, as a result, it would have been obvious to one having ordinary skill in the art that delivering items in a truck are just one of the many methods of delivery.

Further still, the Examiner asserts that the fact that the delivery is performed by a catering is nonfunctional descriptive subject matter. In other words, the fact that it is a catering service providing the delivery service does not affect how the rental and distribution process is carried out and adds little, if anything, to the claim's structure, and, thus, does not serve as a limitation on the claim to distinguish it over the prior art. As claimed, the steps of the invention would be performed the same regardless of who is doing the delivery.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify **the combination of Inselberg and Wakai** in view of **Official Notice** to deliver the requested items in a truck in the event that a large delivery is required.

21. In regards to **claim 15**, **Inselberg** discloses:

accepting payment and credential information at the pickup location in exchange for rental of a self-contained entertainment device for use during an event (**Col. 5 lines 20 – 37**); and

receiving the self-contained entertainment device at a drop-off location after the event in exchange for a return acknowledgement (**Col. 5 Lines 27 – 32; wherein the devices are returned**).

However, **Inselberg** fails to explicitly disclose a method comprising:

Determining whether any number of a plurality of self-contained in-flight entertainment devices stored at a pickup location require deletion of stored audiovisual presentations and addition of other audiovisual presentations and when so, delivering a quantity of the other self-contained in-flight entertainment devices having the other audiovisual presentations stored to the pickup location for exchange with the any number of self-contained in-flight entertainment devices requiring deletion of store audiovisual presentations; and

wherein the self-contained entertainment devices are for in-flight use.

Inselberg discloses that the entertainment devices can be used at a variety of locations and events without changing the teaching of renting out entertainment devices to customers. In other words, the location does not change how the method carries out the rental.

However, for purposes of expediting prosecution **Wakai** discloses that it is old and well known for airlines to have in-flight entertainment and to rent the devices for enjoying the in-flight entertainment.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the teachings **Inselberg** to include in-flight entertainment, as taught by **Wakai**, in order to expand their audience.

However, **the combination of Inselberg and Wakai** fails to disclose:

determining if any number of a plurality of self-contained in-flight entertainment devices stored on board the aircraft require deletion of stored audiovisual presentations and addition of other audiovisual presentations and if so, delivering a quantity of the

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other self-contained in-flight entertainment devices having the other audiovisual presentations stored to the aircraft for exchange with the any number of self-contained in-flight entertainment devices requiring deletion of store audiovisual presentations.

However, **Wakai** does disclose that the in-flight entertainment devices can be preloaded with entertainment, such as movies, video games, and etc. As a result, **Official Notice** is taken that it would have been obvious to one having ordinary skill in the art to exchange the newly ordered IFE devices with the IFE devices already stored on the plane which may be obsolete or having contained outdated entertainment. That is to say, it is old and well known for unnecessary weight, i.e. IFE devices that are no longer needed, to be removed from a plane for safety issues, such as unnecessary fuel consumption, for example.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify **the combination of Inselberg and Wakai** in view of **Official Notice** to exchange the newly ordered IFE devices with the IFE devices already stored on the plane, which were not requested or considered to be obsolete or having contained outdated entertainment.

22. In regards to **claim 16, the combination of Inselberg and Wakai** discloses wherein the pickup location are onboard the aircraft (**Wakai Col. 1 Lines 21 – 23**).

23. In regards to **claim 17, Inselberg** fails to disclose wherein the pickup location is a kiosk counter or a gate counter (**Col. 5 Lines 60 – 32**).

Moreover, the Examiner asserts that it would have been obvious to one having ordinary skill in the art that if the device is rented at the origination airport it would have

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been common sense for the device to be returned at the destination airport. Further still, one having ordinary skill in the art would have found it obvious from the teachings of **Wakai** that the location of where the IFE devices are picked up and dropped off are performed at two different airports (**Col. 1 Lines 21 – 23**). In other words, **Wakai** discloses that if the customer is interested in an IFE device the customer may rent the device and one having ordinary skill in the art would naturally have found it obvious for the customer to return the IFE device at the end of the trip.

Furthermore, the Examiner asserts that the pickup location and drop off location are at counters of two different airports to be considered to be nonfunctional descriptive subject matter. That is to say, the location of where the pickup location adds little, if anything, to the claim's structure, and, thus, does not serve as a limitation on the claim to distinguish it over the prior art. As claimed, the steps of the invention would be performed the same regardless of the location. As is taught by **Wakai**, one having ordinary skill in the art would have found it obvious that the locations of where a customer receives the IFE device would be different from the location of where the IFE device is to be handed in.

Response to Arguments

24. Applicant's arguments with respect to **claims 1 – 17** have been considered but are moot in view of the new ground(s) of rejection.

Rejection under 35 USC 112

25. The rejection under 35 USC 112, second paragraph, has been **withdrawn** due to amendments.

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Rejection under 35 USC 101

26. The rejection under 35 USC 101 has been **maintained** because although the entertainment device is a machine the Examiner asserts that:

- 1) the act of storing and presenting an audiovisual presentation are considered to be insignificant extra solution activities in that the mere act of data gathering and outputting are insignificant and insufficient to overcome the test; and
- 2) most importantly, the entertainment devices is not performing any of the steps of the claimed method. That is to say, the device is not performing the steps of accepting a reservation, adding a reservation to a manifest, comparing the reserved devices with a default number, and brining on an additional amount of devices.

Rejection under 35 USC 103

27. Applicant's arguments with respect to **claims 1 – 7, 10 – 14**, which are directed towards the newly amended limitation that describes that the IFE consists of content previously loaded on the device prior to pickup by the one or more passengers, have been considered but are moot in view of the new ground(s) of rejection.

Official Notice

28. A “traverse” is a denial of an opposing party’s allegations of fact. The Examiner respectfully submits that applicants’ arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants’ arguments and comments as constituting a traverse, applicants’ arguments and comments do not appear to constitute an adequate traverse because

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applicant has not specifically pointed out the supposed errors in the Examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

Here the Examiner asserts that the applicant has failed to properly address the Examiner's **Official Notice** statement in its entirety, i.e. the applicant has failed to properly argue why it was not well known in the art to remove, exchange, or substitute one form of entertainment for another when the entertainment has been deemed obsolete or outdated. The Examiner has presented a rationale and, well known fact, that it would have been obvious to use this well known method as a means of preventing the airline from storing additional entertainment in addition to the obsolete entertainment so that additional fuel is not used, as well as additional cargo/storage space.

The Examiner notes that the claim explicitly states for **exchanging** one content for another. As a result, the applicant's argument that, "The claims therefore do not expressly recite that entertainment devices are removed, but additional entertainment devices are received. In other words, more devices are added such that the weight would be increased," is not entirely correct. To be more specific, by exchanging a device that requires deletion for a device that has, for the sake of argument, more

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updated entertainment is, in essence, removing a device. This is in line with the Examiner's **Official Notice** statement. The Examiner asserts that aircrafts have a predetermined weight and storage capacity and, as a result, one of ordinary skill in the art would have understood that loading an aircraft with unnecessary content would be unwise (**see the Official Notice statement as to why**). However, with that said, the Examiner asserts that one of ordinary skill in the art would have found it obvious that if the carrying capacity of an aircraft is 200 passengers and it was determined that only 180 passengers booked the flight the airline would only provide 180 devices. Moreover, because it is well known in the art that passengers can make last minute changes and book a flight at the last minute, resulting in the aircraft now having, for example, 185 passengers, it would have only been obvious to provide an additional 5 devices for those passengers since it would still be below the 200 capacity limit.

In other words, the additional devices being provided in the claimed invention is understood to be a determination that additional devices are needed in the event that a previous device is deemed to no longer be acceptable and if additional passengers require a device. It is entirely unlikely, as well as unsafe, to provide the aircraft with, for example, 200 devices of outdated content and then providing an additional 200 devices at a later time and another 200 devices at another time, and so on, since such a practice would take up a considerable amount of space on the aircraft (which one of ordinary skill in the art would have found it inherent that an aircraft only has a limited amount of available space) and would increase the weight of the aircraft in an inconsiderate manner.

If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). MPEP 2144.03
Reliance on Common Knowledge in the Art or "Well Known" Prior Art.

In regards to **claim 4 and 9**, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. The Examiner asserts that the term "are" was not being used as a means to 1) denote between the past and present, and 2) the applicant has failed to argue that there was not more than one mode of delivery. That is to say, the applicant is attempting to argue that the applicant has invented the concept of delivery by truck, which the Examiner asserts is completely incorrect and does not address the rejection. The Examiner respectfully requires the applicant to provide evidentiary proof that the applicant has, indeed, invented the concept of truck deliveries, as well as evidentiary support that such as concept was not well known prior to the filing of the applicant's claimed invention.

The Examiner maintains the **Official Notice** rejection and asserts that the applicant is arguing irrelevant semantics/technicalities that fail to overcome the rejection, as well as failing to address the rejection at hand by properly traversing the rejection.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that

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any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

29. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERARDO ARAQUE JR whose telephone number is

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(571)272-3747. The examiner can normally be reached on Monday - Friday 9:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gerardo Araque Jr./
Primary Examiner, Art Unit 3689
10/25/2011